



EXPRESS MAIL LABEL NO. EL35862786US

PATENT REISSUE APPLICATION
Docket No. 11527.209.2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue application of)
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Per Just Andersen, Ph.D., et al.)
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Serial No. 09/390,583) Art Unit
) 1771

Filed: September 2, 1999)
)

For: COATED STARCH-BASED COMPOSITIONS)
 AND METHODS FOR MANUFACTURING)
 STARCH-BASED COMPOSITIONS)

Examiner: Blaine R. Copenheaver)

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DECLARATION IN SUPPORT OF REISSUE APPLICATION

1. We, Per Just Andersen, Ph.D., and Simon K. Hodson (hereinafter "Inventors"), declare that we are the original and sole inventors named in previously filed U.S. application Serial No. 08/327,524, filed October 21, 1994, which issued as U.S. Patent No. 5,662,731 on September 2, 1997, and for which this application for reissue is sought. We further declare that we are citizens of the Kingdom of Denmark and the United States of America, respectively, and have residences and post office addresses at 947 Via Fruteria, Santa Barbara, California 93110 and 4621 Via Roblada, Santa Barbara, California, 93110, respectively. We believe ourselves to be the original, first, and joint inventors of the subject matter of the invention or discovery set forth in said U.S. application Serial No. 08/327,524, which issued as said U.S. Patent No. 5,662,731, and which is the subject of U.S. reissue application Serial No. 09/390,583.

2. E. Khashoggi Industries, LLC (hereinafter "Assignee"), by and through its President, Simon K. Hodson, declares that it is the assignee of the entire right, title and interest in and to U.S. Patent No. 5,662,731, which issued from U.S. application Serial No. 08/327,524, as evidenced by the assignment documents recorded at reel 7371, frame 813 (original assignment from inventors to E. Khashoggi Industries) and reel 8761, frame 333 (subsequent assignment from E. Khashoggi Industries to E. Khashoggi Industries, LLC).

3. The Inventors and Assignee together constitute the "Applicants" of this application for reissue. Applicants have reviewed the aforementioned assignment documents and believe that title is in Assignee seeking to take action.

4. Applicants acknowledge the ongoing duty to disclose information which is material to the examination of this reissue application in accordance with Section 1.56(a) of Title 37 of the Code of Federal Regulations.

5. Applicants believe that U.S. Patent No. 5,662,731 is wholly or partly inoperative by reason of Applicants having claimed less than what the Applicants had the right to claim.

6. Applicants, when drafting and filing the original claims, and when drafting and filing subsequent amendments during prosecution, sought to protect what they considered to be their invention. In particular, Applicants received protection for a starch-based composition as recited in issued claim 1, which reads as follows:

1. A starch-based composition for molding into an article having a starch-bound cellular matrix, the starch-based composition comprising water, a starch-based binder in a concentration greater than about 20% by weight of the starch-based composition, and a fibrous material having an average fiber length greater than about 2 mm and an aspect ratio greater than about 10:1, wherein the fibers are substantially homogeneously dispersed throughout the starch-based composition, wherein the starch-based binder includes a substantially ungelatinized component comprising unmodified starch granules in an amount in a range from about 50% to about 90% by weight of the starch-based binder and a substantially gelatinized component comprising gelatinized starch in an amount in a range from about 10% to about 50% by weight of the starch-based binder prior to molding the composition into the article.

7. It was originally believed that the foregoing claim, as well as the other claims of U.S. Patent No. 5,662,731, adequately protected the invention for which patent protection was sought.

8. Subsequent to the issuance of U.S. Patent No. 5,662,731, Applicants began considering whether to use certain coating materials that were disclosed but not claimed in the application which issued as U.S. Patent No. 5,662,731, on the outer surface of compositions according to U.S. Patent No. 5,662,731. Since the claims that issued in U.S. Patent No. 5,662,731 do not recite these coating materials, they did not provide adequate claim protection that would prevent an infringer from utilizing such coating materials on the outer surface of the inventive compositions. As such, the claims that issued in U.S. Patent No. 5,662,731 are inoperative.

9. Both Applicants and Applicants' attorneys failed to appreciate the inventive nature of the coating materials disclosed in U.S. Patent No. 5,662,731 when such coating materials are used in combination with the starch-based compositions disclosed therein, though the Inventors were clearly in possession of the invention at the time the application was filed. Only after issuance of U.S. Patent No. 5,662,731 did Applicants and Applicants' attorneys come to realize that Applicants could have claimed the specific coating materials in combination with the starch-based compositions disclosed therein.

10. If, during the prosecution of said U.S. Patent No. 5,662,731, more particularly, if during the pendency of said U.S. application Serial No. 08/327,524, Applicants had fully understood the inventive nature of the coating materials when used in combination with the starch-based compositions disclosed therein, Applicants could have sought protection for this invention, either instead of the claims that were actually issued, or in a continuation application that could have only been filed while said U.S. application Serial No. 08/327,524 was still pending.

11. The claims for which patent protection is now being sought appear to be within the scope of the invention that was elected during the pendency of U.S. application Serial No. 08/327,524. In particular, at the time of the election, which was made during a telephone conversation between the Examiner and John M. Guynn on November 1, 1995, claim 1 read as follows:

1. A starch-based composition comprising a starch-based binder in a concentration greater than about 20% by weight, and a fibrous material having an average fiber length of greater than about 2 mm and an aspect ratio of at least about 10:1, wherein the fibers are substantially homogeneously dispersed throughout the composition.

Thus, elected claim 1 was only limited to a “starch-based composition” which included (1) “a starch-based binder” (*i.e.* gelatinized or ungelatinized native or modified starch) and (2) “a fibrous material”. Elected claim 1 did not require that the composition include water or that it be aqueous and flowable rather than in a substantially solidified or form stable state. Such concepts were only added later, subsequent to the election, and did not serve to narrow the elected invention. In view of this, the elected invention exemplified by originally filed claim 1 objectively covered both aqueous and solidified or form stable “starch-based compositions”. According to the specification, such starch-based compositions may also be coated with one or more coating materials, as now

in the claims being presented for the first time. For this reason, the claims as now presented do not constitute impermissible recapture of cancelled subject matter.

12. At the very least, the claims as now presented for the first time do not encompass subject matter that was cancelled in response to the restriction requirement referred to in the Office Action. Instead, the claims now recite a “narrowing limitation that has a material aspect to it” (MPEP 1412.02), namely the recitation of certain coating materials in combination with a starch-based composition. For this additional reason, the claims as now presented do not constitute impermissible recapture of cancelled subject matter, since the subject matter now being claimed was never cancelled because it was never presented in the way now being claimed at any time during the pendency of U.S. application Serial No. 08/327,527.

13. Applicants declare that the foregoing errors being corrected in the present reissue application arose without any deceptive intention on the part of Applicants or Applicants’ attorneys.

14. We declare further that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the reissue application or any patent issuing thereon.

Signed at Santa Barbara, California this 30th day of March 2000.

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Signed at Santa Barbara, California this 30th day of March 2000.

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E. Khashoggi, Industries, LLC (Assignee)

By:


Simon K. Hodson
President

JMG:cm